



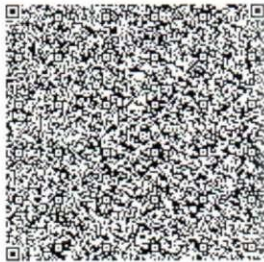
सत्यमेव जयते

## INDIA NON JUDICIAL

### Government of National Capital Territory of Delhi

#### e-Stamp

Certificate No. : IN-DL211757709079980  
Certificate Issued Date : 29-Feb-2016 11:45 AM  
Account Reference : IMPACC (SH)/ dlshimp17/ HIGH COURT/ DL-DLH  
Unique Doc. Reference : SUBIN-DLDSLHIMP17410623563140630  
Purchased by : AMARJIT SINGH ADVOCATE  
Description of Document : Article 12 Award  
Property Description : Not Applicable  
Consideration Price (Rs.) : 0  
(Zero)  
First Party : AMARJIT SINGH ADVOCATE  
Second Party : Not Applicable  
Stamp Duty Paid By : AMARJIT SINGH ADVOCATE  
Stamp Duty Amount(Rs.) : 100  
(One Hundred only)



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## ARBITRATION AWARD

### **.IN REGISTRY – NATIONAL INTERNET EXCHANGE OF INDIA .IN domain Name Dispute Resolution Policy INDRP Rules of Procedure**

#### **IN THE MATTER OF:**

TV Sundram Iyengar and Sons Private Limited  
TVS Building,  
7-B, West Veli Street,  
Madurai 625001  
State of Tamilnadu  
INDIA

.....Complainant

#### **VERSUS**

Matt Sexton  
Matt Sexton  
6-580 Kirkwood Avenue  
Ottawa, Ontario K 1Z 5X4  
Canada

.....Respondent

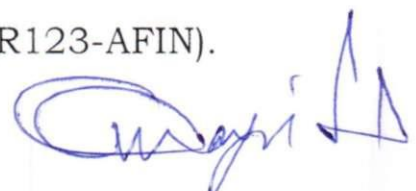
#### **1. THE PARTIES**

The Complainant in this administrative proceeding is TV Sundram Iyengar and Sons Private Limited, TVS Building, 7-B, West Veli Street, Madurai 625001 State of Tamilnadu, INDIA.

The Respondent is Matt Sexton 6-580 Kirkwood Avenue, Ottawa, Ontario K 1Z 5X4 Canada.

#### **2. THE DOMAIN NAME AND REGISTRAR**

The disputed domain name **<www.tv.s.co.in>** has been registered by the Respondent. The Registrar with whom the disputed domain is registered is IN Registrar d.b.a. inregular.com (R123-AFIN).



### **3. PROCEDURAL HISTORY**

3.1 The Complaint was filed with the .In Registry, National Internet Exchange of India (NIXI), against Matt Sexton 6-580 Kirkwood Avenue, Ottawa, Ontario K 1Z 5X4 Canada. The NIXI verified that the Complaint together with the Annexures to the Complaint had satisfied the formal requirements of the .in Domain Name Dispute Resolution Policy ("The Policy") and the Rules of Procedure ("The Rules").

3.2 In accordance with the Rules, Paragraph-2(a) and 4(a), NIXI formally notified the Respondent of the Complaint and appointed me as a Sole Arbitrator for adjudicating upon the dispute in accordance with The Arbitration and Conciliation Act, 1996, Rules framed there under, .In Dispute Resolution Policy and Rules framed there under on, November 24, 2015. The parties were notified about the appointment of an Arbitrator on November 27, 2015.

3.3 The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI to ensure compliance with the Rules (paragraph-6).

3.4 After my appointment as an Arbitrator, I intimated the parties of my appointment and by my email of December 2, 2015, the

of the complaint as well as the annexures to the Respondent at its registered email ID as appearing in WHOIS record of the disputed domain name. Simultaneously, I also sought proof of the delivery of the complaint as well as all the annexures to the respondent from .In Registry.

3.5 NIXI, by its email of December 2, 2015 informed me that hard copy of the complaint along with Annexures were sent to the respondent on 27.11.2015 by Courier and copy of the Courier consignment receipt was also provided.

3.6 The Respondent, vide its e-mail dated December 30, 2015, submitted his response to the complaint.

3.7 The Panel considers that according to Paragraph-9 of the Rules, the language of the proceedings should be in English. In the facts and circumstances, in-person hearing was not considered necessary for deciding the Complaint and consequently, on the basis of the statements and documents submitted on record, the present award is passed.

#### **4. FACTUAL BACKGROUND**

4.1 The case set up by the complainant in the complaint is that the Complainant TV

claimed to have been established in 1911 and the holding company of "TVS Group" being a leading automotive dealership and distribution company in India. TV Sundram Iyengar & Sons Private Ltd. and its group of companies are one of the India's largest Industrial conglomerates. The Complainant is a leading distributor of commercial vehicles, multi-utility and sports utility vehicles, three wheelers, passengers' cars etc. The complainant claims to operate through its three main divisions TVS & Sons, Sundaram Motors and Madras Auto service.

4.2 The Complainant submits that it had honestly adopted TVS as a trademark in the year 1966, which was invented from the name of its founder Thirukkurungudi Vengadam Sundaram Iyengar. The said mark has since then been in consistent and extensive use by the Complainant. Further, the Complainant has also permitted the companies in the TVS group to use TVS both as a part of their trade name and trade mark.

4.2 The Complainant is the trading and distribution arm of the TVS group and the business activities of the complainant include Dealerships for automobile vehicles, Distribution of spares for after- market, products for off highway application like Construction & Material handling. In view of

trademark TVS had had an extensive reach and has left an indelible mark in the minds of the end customers and people in the Trade.

4.3 The Complainant submits that the reputation associated with the trademark 'TVS' is such that it has percolated to goods/services of any nature. Any product/services offered under the trademark 'TVS' connotes and denotes distinct reputation and eminence and goodwill associated with the quality of products manufactured, marketed and serviced and otherwise dealt-with by the complainant and its group of companies.

4.4 The Complainant also submits that it is prior adopter and user of the trademark 'TVS' in respect of its distinguished products and services and has been trading under the said name extensively across the world. The said products and services of the complainant are identified and availed by the trader and consumers throughout the world under the well-known trademark 'TVS'.

4.5 The Complainant further submits that he has been extensively advertising their products and services through various printed media including newspapers, magazines and trade journals, leaflets and other promotional literature depicting the said trademark which have been extensively distributed through

television and due to the superior quality of the complainant's goods and services, the trade mark of the complainant, has acquired immense reputation and goodwill amongst the trade and public. None except, the Complainant, has any justification whatsoever to adopt and use the said well-known trade mark hence, there cannot be any possible explanation for an individual/trader to adopt similar trade mark in respect of any goods/services. By virtue of the extensive use and advertisement of the said mark, the mark is solely associated with the Complainant and no one else. The Complainant further submit that the use of the keyword 'TVS' in any leading search engine automatically throws the web pages of the complainant among the leading hits.

- 4.6 The Complainant also submits that on account of extensive usage of the trademark 'TVS', the said mark is identified solely and exclusively only with the complainant and none other. Further, the 'TVS' brand, has gained a huge customer base nationally as well as internationally and is identified, associated and recognized only with the Complainant. Therefore, adoption and/or usage of the mark 'TVS' by others would amount to not only dilution of the complainant's rights over the distinct mark but also would result in confusion and deception by any unauthorized

the complainant's mark, 'TVS', and domain names comprising of 'TVS' by others would also amount to infringement and passing off actions and is liable to be prevented in Courts of Law. The activity of the disputed domain holder is nothing but an act of cybersquatting.

- 4.7 The respondent's main case is that the domain name TVS.CO.IN was adopted bonafidely, honestly and was registered to create a website providing information about televisions. The respondent also claim to be prior adopter of the domain name in India and that the services offered by the respondent are completely different from the services in respect whereof the complainant claims to have adopted or used the mark TVS. The plea of the mark TVS being common to trade is also raised by the respondent. The plea of delay, acquiescence and laches has also been raised.

## **5. PARTIES CONTENTIONS**

### **5A COMPLAINANT**

- 5A.1 The Complainant and its group of Companies are one of India's largest Industrial conglomerates. The Complainant is the trading and distribution arm of the TVS group, the business activities of the Complainant include Dealerships for automobile vehicles, Distribution of spares

application like Construction & Material handling. In view of the wide ambit of business activities, the trade mark TVS has had an extensive reach and has left an indelible mark in the minds of the end customers and people in the Trade.

5A.2 The Complainant's global business operations include establishing and managing joint ventures/ alliances for automobile distribution / dealership business , sourcing and supply chain related activities. The Complainant has extensive presence in countries like Sri-Lanka and Bangladesh. The Complainant is the distributor to several commercial & Multi-Utility Vehicles , passenger cars and three wheelers to several leading automobile vehicle manufacturers such as Honda , Renault , Ashok Leyland , Mahindra & Mahindra , Daimler Chrysler , Volkswagen and off highway equipment manufactured by Escorts , JLG, Ingersoll Rand , Pal Finger & Leyland Deere. The Complainant has more than 150 Outlets, sells around 6000 Vehicles and services more than 600000 vehicles per annum. The Complainant is also the largest distributor in automobile spare parts in India, handling more than 80 suppliers, 8090 customers and 35000 part numbers and markets TVS quality branded products. The aforementioned mind

visibility and reputation associated with the trade mark / trade name TVS.

5A.3 The illustrious history of the Complainant is well illustrated by the various Mile-Stones reached by the Complainant as listed below:

- 1911 TVS & Sons established in Madurai, Tamil Nadu
- 1912 Starts first rural bus service in Southern Tamil Nadu {from Pudukottai to Thanjavur }
- 1919 Forays into vehicle sales, service and spare parts
- 1929 Foray into Dealership Business representing General Motors
- 1930 Bus Body Building operations started
- 1936 Madras Auto Service acquired
- 1939 Southern Roadways started & Built TVS Service station, Biggest in Asia then.
- 1943 Designs a unique gas plant that uses charcoal gas as fuel instead of petrol which was in short supply during World War II
- 1945 Sundaram Motors formed
- 1956 T V Sundram Iyengar was honoured by the Union Government of India by unveiling busts in Bronze and in Marble in the city of Madurai (Tamilnadu).
- 1996 Enters logistics business
- 2003 Enters customers centric car service business under brand name "MyTVS"
- 2004 Logistics business was hived off as a separate company called "TVS Logistics Services Limited"

- 2008 Forays into parts retail business for Heavy & Light Commercial Vehicle under brand name "TVS PartSmart"
  - 2011 MyTVS, the Customer Centric Car services business was hived off as a separate company called "TVS Automobile Solutions Limited"
  - 2012 The All Car Services business of TVS Automobile Solutions Limited expanded its network into Kolkata & Gujarat through separate JV's
  - 2012 Acquisition of Universal Component, United Kingdom
- 5A.4 The Complainant operates in diverse fields such as automotive component manufacturing, Two-wheeler manufacturing, automotive dealership, finance and electronics, as well as into Information technology solutions and services. Currently, there are over thirty companies in the TVS group, employing more than 40,000 people worldwide and with a turnover in excess of USD 4 billion. The TVS Motor the flagship Company of the TVS Group, is the third largest two- wheeler manufacturer in India and one among the top ten in the world. The said Company was awarded the 'Star performer – Silver Shield' in two/three wheelers category, by EEPC India, for excellent export performance for the year 2007-2008. Over the years the TVS Group companies have been recipients of several

of some of the Companies forming a part of TVS Group, to name a few.

- TVS Logistics Services Limited
- TVS infrastructure Limited
- TVS Motor Company Limited
- Lucas-TVS Limited
- TVS America Inc
- TVS Auto Bangladesh Ltd,
- Delphi-TVS Ltd,
- Brakes India Ltd
- Sundaram Clayton Limited
- TVS Srichakra Limited
- TVS RHR Finished Vehicles Logistics Solutions limited
- TVS Dynamic Global Freight Services Limited
- TVS Commutation Solutions Limited
- TVS GMR aviation Logistics Limited
- Flexlol Packaging (I) Limited
- TVS SCS Limited, UK
- TVS Auto Serv GMBH, Germany
- TVS Logistics Iberia SL., Spain
- TVS Logistics Investment USA Inc,
- TVS Logistics Investment UK Ltd,

TVS Logistics Siam Ltd, Thailand

5A.5 The complainant contends that the ‘TVS’ is used both as a trade mark and trade name and forms an essential and dominant part of the corporate name of the majority of the TVS

name, the same has attained distinctiveness and has come to be solely associated with the Complainant and its Group companies in India and in other jurisdictions. The trade mark TVS has acquired significant reputation and squarely falls within the definition of the well-known trade mark as prescribed under section 2(1)(z) of the Trade Marks Act. By reason of popularity, demand and extensive use, which has been acknowledged by the trade and public, the goods/services under the trade name/mark 'TVS' has become distinctive of the Complainant's business. As a result, the trade and public associate the trade mark 'TVS' particularly with the Complainant and none else and the said mark of the Complainant has acquired a secondary meaning in the course of trade. As, 'TVS' has proved to be a perfect amalgamation of heritage, business ethics and efficiency, it has resulted in tremendous popularity world-over and has become iconic in India.

5A.6 The Complainant and its group companies have following trade mark registrations in India and in few other jurisdictions:-

COUNTRY	TRADEMARK	NUMBER	CLASS	REGISTERED & RENEWED UP TO
INDIA	TVS	109706	11	25-APR-2019
INDIA	MY TVS (DEVICE)	1724541	36 & 42	23-AUG-2018

INDIA	TVS	298601	6	21-AUG-2019
INDIA	TVS	487159	6	09-MAR-2019
UK	TVS	00003018 391	12	15-AUG-2023
EU	TVS	01092912 3	7,9,11, 12,16, 35,39, 42	31-MAY-2022

5A.7 The Complainant and its group of companies are the original owner of the following domain names:

SL. NO.	DOMAIN NAME
i.	Tvs.in
ii.	Tvsmotor.co.in
iii.	Tvsgroup.com
iv.	Tvsinfotech.com
v.	Tvstge.asia
vi.	Tvsiyengar.cn
vii.	Tvs-autoserv.cn
viii.	Tvsiyengar.com.hk
ix.	Tvsiyengar.com.tw
x.	Tvsiyengar.tw
xi.	Tvstge.tw
xii.	Tvstge.com.tw
xiii.	Tvsautoserv.es
xiv.	Tvs-autoserv.es
xv.	Tvsiyengar.es

5A.8 It is stated that the impugned domain name **www.tvn.co.in** is identical to the Complainant's registered well-known trademark 'TVS', which enjoys a wide reputation, goodwill and recognition of very high order.

5A.9 It is stated that an innocent customer is bound

www.tv.s.co.in registered by the Respondent. The facts and circumstances in the present case prove beyond doubt that the Registration of the impugned Domain name by the Respondent amounts to "passing off" with a manifest intention to commit fraud to mislead innocent and gullible customers by resorting to unfair and dishonest trade practices.

5A.10 It is stated that it is well settled by various WIPO case-decisions as in Telstra Corporation Limited V/s Nuclear Marshmallows (Case No. D2000-0003) and Bharatiya Janata Party (BJP) Vs lahead, Vinay KM (Case No. D2011-0768) that the relevant issue is not whether the respondent is undertaking a positive action in bad faith in relation to the 'domain name' but instead whether, in all the circumstances of the cases, it can be said that the Respondent is acting in bad faith. It has thus been held that the concept of Domain Names being used in bad faith is not limited to positive action; but inaction is very much within the concept.

#### B. RESPONDENT

5B(1) The Respondent, vide e-mail dated December 30, 2015, submitted its response to the Complaint before this panel in respect of the disputed domain name www.tv.s.co.in.

5B(2) The Respondent submitted that he has honestly and bonafidely adopted and registered the domain name TVS.CO.IN for using the same to create a website providing information about televisions.

5B(3) The Respondent also submitted that it is the "prior adopter" of the said domain name in India and is not required to seek any authorization or approval from the complainant. The Respondent denied that the said domain name is identical to the complainant's domain name, as alleged or otherwise.

5B(4) The Respondent further contends that he was not aware of the complainant until he received the complaint in this proceeding and has no knowledge whether the representations by the complainant about its business are true.

5B(5) The Respondent denied that the use or registration of the said domain name would amount to infringement or passing off or that such use is liable to be prevented in courts of law.

5B(6) The Respondent further stated that the complaint should be rejected on the basis of the following submissions:-

- i. The Respondent has honestly and bonafidely adopted TVS without any awareness of Complainant. The Complainant does not do

TELEVISIONS. The Respondent also submits that the search result on google do not show the complainant at all; rather they show websites about televisions. In the absence of proof that the Respondent had knowledge of the complainant's mark and intended to target the complainant, when it registered TVS.CO.IN., the complaint must fail.

- ii. The Respondent is not aware of the complainant's mark TVS and it is only when the Respondent received the complaint in these proceedings that the Respondent became aware of the complainant and of its marks. The TVS.CO.IN domain does not make even slightest of reference to the complainant or its business and does not in any way create any likelihood of confusion to make the visitors believe that the website WWW.TVS.CO.IN is any way associated with or sponsored by the complainant.
- iii. The Respondent also submits that he has or had no intention of violating the complainant's alleged rights. The Respondent intends to use the said domain name TVS.CO.IN bonafidely in respect of a website offering information about televisions.
- iv. The Respondent also submits that TVS is a non-distinctive acronym and is used for Televisions and the complainant cannot claim any monopoly on the term.
- v. The Respondent further submits that there are a number of companies other than the

applied/registered TVS as a trademark which are co-existing without any likelihood of confusion.

- vi. The Respondent also submits that there are many other corporations apart from the complainant using the TVS domain name in respect of their websites.
- vii. The Respondent also submits that the products/services offered by the complainant and the respondent are completely different and distinct. Thus, there is no likelihood of confusion. The domain TVS.CO.IN does not and has never made any reference to the complainant.
- viii. The Respondent also submits that the domain TVS.CO.IN has been registered since February 16, 2005, and the complainant has filed the complaint only now, i.e. nearly 11 years after the domain name was created. Further, the complainant did not raise any opposition during the 'Sunrise Period' that was made available under INDRP for the trademark proprietors to raise objections against such registrations that they think would infringe their trademarks. The complainant is guilty of delay, laches and acquiescence. The long delay also raises an interference that the complainant did not truly believe the respondent engaged in bad faith registration.

### **C. REJOINDER**

5C.1 The Panel, vide its e-mail dated January 4,

complainant to file its rejoinder, if any, in terms of the submissions made by the Respondent. The Complainant, by its e-mail dated January 12, 2016, filed rejoinder to the response filed by the respondent.

5C.2 The Complainant by its rejoinder made the following submissions:-

- i. That by virtue of long, continuous and extensive use of the mark TVS for more than a century, huge impact has been created in the minds of the consumers with reference to TVS. The said trademark TVS has acquired distinctiveness, reputation and goodwill and has developed a secondary meaning in the market, which is associated exclusively with the complainant's business and the goods and services emanating there from. It is absolutely irrelevant that the Complainant does not do business in Canada as the Internet today has become a global market which has broken the boundaries for trade mark visibility and reputation.
- ii. The Complainant refuted that the Respondent was not aware of the Complainant, when in fact he was aware that TVS.IN was registered in the name of one of the group companies. Further, after realizing the reputation of the TVS brand in India had strategically blocked the sub-category CO.IN extension with an intention to ride on the Complainant's reputation or to sell to a third party , who is

The Respondent till date has not made any effort to activate the impugned domain name to sell Televisions, as frivolously claimed in his defense.

- iii. The Complainant refuted the case that the Respondent has no intention to violate the Complainant's trade mark rights. The Complainant also submitted that The Respondent has not used the Domain since 2005 at all, leave alone intending to provide information on Televisions. The Respondent's intention is to exploit and ride on the goodwill of the complainant or to merely sell the impugned Domain to a third party interested to infringe the trade mark rights of the Complainant in India and in other jurisdictions.
- iv. The Complainant has firmly refuted that TVS is a non-distinctive acronym widely used for Televisions. The documents submitted by the complainant, as Exhibit-B, clearly show that the websites in India have used TVs (with S as a small letter) as an acronym for Television. On the other hand, TVS is a well-known trade mark in India derived from the founder's name T V Sundaram Iyengar and Sons. Therefore, it is reiterated that the Respondent's lame defense that TVS is a commonly used acronym is wrong and without any valid ground.
- v. The Complainant strongly denied that a number of companies other than the complainant have trade mark registration for

India Limited, Sundaram-Clayton limited and TVS Srichakra Limited are all a part of the TVS group of Companies. A download from the complainant's website on its group companies, is enclosed as Annexure 1. The remaining marks in the list provided have been abandoned or have lapsed. The only other valid registration is under No. 262116, the trade mark in this registration is not TVS TORSION, but has been amended to TVSTORSION as one word, in view of the existence of the TVS registration in the name of Sundaram-Clayton, one of the group companies. The Complainant deny the claim that there are other corporations using the TVS domain name, the domain names are not merely TVS and are combined with other elements. In any case, a google search from India for TVS would only reveal information on the Complainant and its group companies. It is absurd on the part of the Respondent to submit that the products/services of the Respondent and Complainant is different, when the only objective of the Respondent has been to sell the impugned domain to a third party wanting to Infringe on the trade mark rights of the Complainant.

## **6. DISCUSSIONS AND FINDINGS**

6.1 The Complainant, while filing the Complaint, submitted the following

Dispute Resolution Policy and the Rules framed thereunder in terms of paragraph (3b) of the Rules and Procedure. The Respondent also submitted to the mandatory arbitration proceedings in terms of paragraph 4 of the policy, while seeking registration of the disputed domain name.

- 6.2 Paragraph 12 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and that there shall be no in-person hearing (including hearing by teleconference video conference, and web conference) unless, the Arbitrator, in his sole discretion and as an exceptional circumstance, otherwise determines that such a hearing is necessary for deciding the Complaint. I do not think that the present case is of exceptional nature where the determination cannot be made on the basis of material on record and without in-person hearing. Sub-Section 3 of Section 19 of The Arbitration & Conciliation Act also empowers the Arbitral Tribunal to conduct the proceedings in the manner it considers appropriate including the power to determine the admissibility, relevance, materiality and weight of any evidence.

- 6.3 It is therefore, appropriate to examine the issues in the light of statements and documents submitted as evidence as per Policy, Rules and the provisions of the Act.
- 6.5 Under the provisions of Order 8 Rule 5 of the Code of Civil Procedure, 1908 the material facts as are not specifically denied are deemed to be admitted.
- 6.6 The decision of Hon'ble Supreme Court of India in the matter of **Jahuri Sah Vs. Dwarika Prasad** – AIR 1967 SC 109, be referred to. The facts as are admitted expressly or by legal fiction require no formal proof. (See Section 58 of the Indian Evidence Act, 1872). The material facts stated in the complaint have neither been dealt with nor specifically disputed or denied by the Respondent.
- 6.7 Paragraph 10 of the Policy provides that the remedies available to the Complainant pursuant to any proceedings before an arbitration panel shall be limited to the cancellation or transfer of domain name registration to the Complainant.
- 6.8 Paragraph 4 of the Policy lists three elements that the Complainant must

name of the Respondent to be transferred to the Complainant or cancelled:

A. **IDENTICAL OR CONFUSINGLY SIMILAR**

6A.1 The Complainant contends that the Registrant's Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights.

6A.2 The Complainant and its group companies are the Registered proprietor of the trade mark 'TVS' in India and in few other jurisdictions. The details of few of such Registrations are:-

COUNTRY	TRADEMARK	NUMBER	CLASS	REGISTERED & RENEWED UP TO
INDIA	TVS	109706	11	25-APR-2019
INDIA	MY TVS (DEVICE)	1724541	36 & 42	23-AUG-2018
INDIA	TVS	298601	6	21-AUG-2019
INDIA	TVS	487159	6	09-MAR-2019
UK	TVS	00003018 391	12	15-AUG-2023
EU	TVS	01092912 3	7,9,11,1 2,16,35, 39,42	31-MAY-2022

6A.3 The Complainant stated that the impugned domain name **www.tvs.co.in** is identical to the Complainant's registered well-known trademark 'TVS', which enjoys a wide reputation, goodwill and recognition of very high order.

6A.4 The Complainant also stated that the respondent wrongfully and fraudulently adopted and registered the impugned domain name **www.tvb.co.in** to utilize the name and reputation attached to the well-known mark 'TVS' without having any rights thereto and in spite of having knowledge about the complainant and the reputation associated with 'TVS'.

6A.5 The Complainant further stated that he has not licensed or otherwise permitted the respondent to use its trademark 'TVS', nor has it permitted the Respondent to apply for or use any 'Domain Name' incorporating the mark 'TVS'.

6A.6 The Respondent contends that the Trade Mark rights are jurisdictional and the Complainant has no presence and/or is not known in Canada where the Respondent resides.

6A.7 The primary question before this Panel under the INDRP Policy is to decide that whether the Registrant's Domain Name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has right under Rule 4(i) of the Policy.

6A.8 .In Registration Policy state that .IN Domain Names are available to anyone be it companies, individuals or organizations in

6A.9 The Complainant in the present proceedings has been able to put forth before this Panel the registrations in India and few other countries in the world for the trade/service mark TVS, which is not disputed by the Respondent.

6A.10 The Respondent on the other hand has stated that it has plan to provide information regarding TVS in Canada though no use thereof has been demonstrated before this Panel.

6A.11 The Respondent also contends that the term TVS is a generic term associated with Television.

6A.12 In view of the submissions of the parties, this Panel decides that the Complainant has right in the mark TVS by virtue of their registration and use of the mark in India, U.K. and E.U.

6A.13 Therefore, the Complainant is successful in establishing the first element of INDRP and the panel finds that the disputed domain name is confusingly similar to the TVS mark. Consequently, the first requirement of paragraph 4 of the policy is satisfied.

**B. RIGHTS OR LEGITIMATE INTEREST**

The Complainant submits that:-

6B.1 The Respondent has no right or legitimate interest in respect of the impugned domain name.

6B.2 Paragraph 7 of the Policy lists the following three non-existence methods for determining whether the Respondent has rights or legitimate interest in the disputed domain name:

*(i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;*

*(ii) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or*

*(iii) the Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.*

6B.3 The Domain Names under the Policy are available to anyone on first come first served basis. In case, any person or organization claims right over the Domain Name as violation of its trade/service mark rights, the

the right in the mark and the burden thereafter shifts to the Respondent to prove its legitimate interest and the use of the Domain Name in good faith.

6B.4 The trademark rights as are granted under the respective statutes of each country are territorial in nature. The Panel agree with the contention of the Respondent that the Complainant has not been able to establish its right in the trade/service mark TVS in Canada. However, the goodwill and common law rights have no such territorial boundaries. In today's world, the goodwill travel beyond geographical boundaries of countries. The Panel further agree with the Respondent that the term TVs can be used for television provided the same is used in a generic bonafide manner.

6B.5 The Respondent has failed to show any demonstrable preparations to use the Domain Name or a Name corresponding to the Domain Name in connection with bonafide offering of goods or services through the impugned Domain Name <tv.co.in>.

6B.6 The Respondent has provided evidence from the Search Engine for the term TVS showing results relating to Television, but has failed to provide any evidence of use or preparation of use for the impugned Domain Name

show the use of TV brands and the word TVs is used in a bonafide generic manner and not as a trademark or service mark or as a domain name. There is a difference between a generic descriptive bonafide use of a common word than the use as a mark. It is well established that the domain name in the context of e-commerce preform the role of a trademark. The evidence filed as Exhibit-A, B & D, therefore, does not advance the case of the respondent in any manner. Exhibit-C does not prove the common use of the mark TVS. There is a distinction between a mark being registered than a mark being actually used in the course of trade. In order to succeed, on the plea of common to trade, it is necessary in the course of trade to prove actual common use. (Reference may be made to judgement of the Division Bench of the Hon'ble High Court of Delhi in the matter of Century Traders Vs. Roshan Lal AIR 1978 Delhi 250.

6B.7 The Respondent is not commonly known by the Domain Name.

6B.8 The Panel rely upon the judicial and administrative decisions in support of the above findings:-

- i. Creative Technology Ltd. Vs. Cleveland Polite (Case No. D2006-1211).
- ii. Marker Volkl (International) GmbH Vs.

- iii. The Knot, Inc. Vs. In Knot We Trust Ltd.  
(Case No. D2006-0340).
- iv. International Business Machines Corporation (IBM) Vs. Guanbing Meng  
(Case No. DCC2011-0006).

6B.9 The Impugned domain name was registered on 16.02.2005 as per Annexure-B to the complaint. The perusal of Annexure-G to the complaint show that the first registration of trademark TVS under no. 109706 was made as of 25.01.1945. There are other registrations made in the year 1974 & 1988 in the name of the complainant. The Respondent, therefore, cannot claim to be the proprietor adopter or prior user of the impugned domain name.

6B.10 The issue whether the Registrant is making a legitimate, non-commercial or clear use of the Domain Name does not arise as the said Domain Name has never been used for bonafide offering of goods or services by the Respondent.

6B.11 In view thereof, the Panel concludes that the Respondent has no common right or legitimate interest in respect of the Domain Name <tvS.co.in>.

### **REGISTERED IN BAD FAITH**

6C.1 For a Complainant to succeed, the Panel

has been registered and is being used in bad faith.

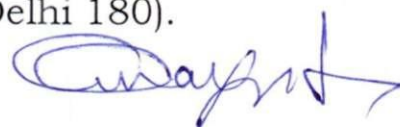
6C.2 For the purposes of establishing registration and use of Domain Name in bad faith by the Complainant, any of the following circumstances should be present:-

- i) Circumstances indicating that the Registrant has registered or acquired the Domain Name primarily for the purpose of selling, running or otherwise transferring the Domain Name registration to the Complainant, who bears the name or is the owner of the trade mark or service mark, or be a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the Domain Name; or
- ii) The Registrant has registered the Domain Name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding Domain Name, provided that the Registrant has engaged any pattern of such conduct; or
- iii) By using the Domain Name, the

admitted to attract Internet users to the Registrant's Website or other online location, by creating a likelihood of confusion that the Complaint's name or mark as to the source, sponsorship, affiliation or endorsement of the Registrant's Website or location or of a product or service on Registrant's Website or location.

6C.3 The disputed domain name, as aforesaid, was registered on 16.02.2005. During the past 11 years, the Respondent did not make any bonafide use of the domain. The said fact strongly indicate the circumstances that the respondent acquired the disputed domain name primarily for the purpose of selling or otherwise transferring the same to the complainant or to any other competitor for valuable consideration in excess of the respondent's documented out of pocket cost directly related to the acquisition of the domain name. The manner in which the mark TVS of the complainant has been taken also demonstrate the lack of good faith as any bonafide reference to televisions ought to have been made by the use of the word TV and/or TVs. The contention of the respondent that the abbreviation TVS is generic or descriptive in respect of the goods or services of the complainant cannot be accepted. The law on this aspect is settled by the Division Bench of the Hon'ble High Court of Delhi in the matter of Himalaya Drug Company Vs. S.B.L. Ltd.

there was no explanation, or other logical reason for the registration of the domain name other than to take advantage of any confusion with the complainant's mark. The Panel, however, considered that such cases often arise if the trademark was a coined word. Having taken the said view, based on UDRP decisions, the panel in the case no. D2014-0814, took the view that the mark TVS was not a coined mark. With due respect to the panel deciding the said case, this panel disagree with the said view that the mark TVS is a not a coined mark. The view of this panel is fortified by the decision of the Division Bench of Delhi High Court in the matter of Himalaya Drug Company Vs. S.B.L. Ltd. 2013 (53) PTC 1 that even the descriptive marks are capable of acquiring distinctiveness and are protected. The trademark TVS is the registered trademark of the complainant in India and other jurisdiction and such registration(s) in itself are the evidence of the fact that the Registrar of Trademarks considered the trademark TVS distinctive or capable of distinguishing. Even otherwise there are large number of decisions of the courts in India where the descriptive words are considered to have acquired distinctiveness on account of long and exclusive use and such marks have duly been protected. (Reference may be made to the judgement in the matter of Registrar of Trademarks Vs. Hamdard National Foundation AIR 1980 Delhi 180).

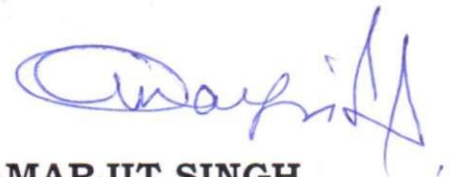


6C.7 In the said circumstances, the Panel concludes that the registration of impugned Domain Name was obtained in bad faith.

7. **DECISION**

The Complainant has succeeded in establishing all three elements of the policy.

In view of the above discussions, the Panel direct the transfer of impugned domain name <tvS.co.in> to the complainant.



**AMARJIT SINGH**  
Sole Arbitrator

Dated: 27<sup>th</sup> February, 2016